REMARKS

By this amendment, claims 1, 4, 12-14, 18 and 20 have been amended. Claims 3 and 16 have been cancelled. Claims 1, 2, 4-15, and 17-20 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, are respectfully requested.

Rejection under 35 U.S.C. § 103

Claim 1

Claim 1 recites a method of automatically generating a list of favorite media selections of a user of a media presentation device offering a plurality of media selections, comprising: recording for each of a plurality of selections a total time that each of the plurality of selections have been selected on the media presentation device over a particular period of interest, wherein recording includes: (i) for each occurrence of selecting one of the plurality of selections over the particular period of interest, at least (*a*) recording in a first table entries of a start time, an end time, a date, and a corresponding selection identification number, wherein a total time per occurrence corresponds to a difference between the end time and the start time, and (*b*) deleting from the first table entries that no longer occur within the particular period of interest, and (ii) periodically referencing the first table to perform at least one of generating and updating a second table, wherein the at least one of generating and updating the second table includes (*a*) using entries of the first table per selection to calculate a cumulative total time for each of the plurality of selections that have been selected over the particular period of interest and (*b*) recording each cumulative total time for corresponding selections as entries of the second table; and generating from the entries of the second table a favorite selection list, the favorite selection list including up to N selections of the plurality of selections corresponding to those most frequently selected as determined from (*a*) the recorded cumulative total time that each of the

plurality of selections has been selected over the particular period of interest and (*b*) only if the recorded cumulative total time of a corresponding selection during a sampling period within the period of interest exceeds a threshold, further wherein N is a predetermined number of selections to be included on the favorite selection list.

Claims 1, 2, 3, 4, 7, 8, 9, 11, 13, 14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (US 6078348) in view of Hernandez (Database Design for Mere Mortals). With respect to claims 3 and 16, the same have been cancelled herein, thus rendering the rejection thereof moot. Applicant respectfully traverses this rejection on the grounds that these references are clearly defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Klosterman patent and the Hernandez reference cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains* ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, **all** limitations of the claim **must be** evaluated. However, since neither Klosterman nor Hernandez teaches *automatically* generating a list of favorite media selections that includes the **specific combination of:**

> (i) for each occurrence of selecting one of the plurality of selections over a particular *period of interest*, **(*a*)** *recording* in **a first table** entries of a *start time*, an *end time*, a *date*, and a *corresponding selection identification number*, and **(*b*)** *deleting* from **the first table** entries that *no longer occur* within the particular *period of interest*, and
>
> (ii) *periodically referencing* **the first table** to perform at least one of *generating and updating* **a second table**, wherein ... *generating and updating* **the second table** includes **(*a*)** *using* **entries** of **the first table** per selection *to calculate* a cumulative total time for each of the plurality of selections that have been selected over the particular period of interest and **(*b*)** *recording* each cumulative total time for corresponding selections as entries of **the second table**; **and**
>
> **generating** *a favorite selection list* from the entries of **the second table** *as determined from* **(*a*)** the recorded cumulative total time that each of the plurality of selections has been selected over the particular period of interest **and (*b*) *only if*** the recorded cumulative total time of a corresponding selection during **a sampling period** *within* the period of interest *exceeds* a threshold ... ,

as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

As indicated in the office action, the Hernandez reference teaches:

"In some instances, a table contains more than one set of the type of duplicate fields just described. Fortunately, each set of duplicate fields is resolved in the same manner. Figure 7-19 shows such a table. In the SALES INVOICES table, the fields Item 1, Item 2, and Item 3 constitute one set of duplicate fields, and the fields Quantity 1, Quantity 2, and Quantity 3 constitute another set of duplicate fields. Remove the field Item 1, Item 2, and Item 3 and consolidate them into one field called Item; use Item as a replacement for these three fields. Then remove the fields Quantity 1, Quantity 2, and Quantity 3 and consolidate them into one field called Quantity; use Quantity as a replacement for these three fields. Now you can enter as many items as you need for each "Sales Invoice." When you're done, your table should look like the one shown in Figure 7-20." (Page 3).

However, as indicated above, the claimed embodiment of the present application is directed towards: **(ii)** *periodically referencing* **the first table** to perform at least one of *generating and updating* **a second table**, wherein ... *generating and updating* **the second table** includes **(*a*)** *using* **entries** of **the first table** per selection *to calculate* a cumulative total time for each of the plurality of selections that have been selected over the particular period of interest and **(*b*)** *recording* each cumulative total time for corresponding selections as entries of **the second table**, and which is distinguished from the consolidation of more than one set of a type of duplicate fields (Item: Item 1, Item 2, Item 3; and Quantity: Quantity 1, Quantity 2, and Quantity 3) of Hernandez. Thus, the table consolidation of Hernandez clearly teaches away from the first and second tables of claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Klosterman patent and the Hernandez reference cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Klosterman nor Hernandez teaches, or even suggests, the desirability of the combination since neither teaches the specific **combination of**:

> **(i)** for each occurrence of selecting one of the plurality of selections over a particular *period of interest*, *recording* in **a first table** entries of a *start time*, an *end time*, a *date*, and a *corresponding selection identification number*, and
>
> **(ii)** *periodically referencing* **the first table** and *generating and updating* a **second table (a)** *using* **entries** of **the first table** per selection *to calculate* a cumulative total time for each of the plurality of selections that have been selected over the particular period of interest and **(b)** *recording* each cumulative total time for corresponding selections as entries of **the second table**; **and**
>
> **generating** *a favorite selection list* from the entries of **the second table** *as determined from* **(a)** the recorded cumulative total time **and (b)** ***only if*** the recorded cumulative total time of a corresponding selection during **a sampling period** *within* the period of interest *exceeds* a threshold,

as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

Accordingly, for at least the reasons stated herein, claim 1 recites a method of automatically generating a list of favorite media selections that is clearly patentably distinct over the art of record.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested.

Dependent claims 2, 4, 7, 8, 9 and 11 depend from and further limit, in a patentable sense, independent claim 1 and therefore are allowable as well.

Claim 13 is similar to claim 1 and is now believed allowable for similar reasons stated above with respect to the allowability of claim 1.

Dependent claim 14 depends from and further limits, in a patentable sense, independent claim 13 and therefore is allowable as well.

Claims 5, 6, 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (US 6078348) and Hernandez in view of applicants

admitted prior art. Applicant respectfully traverses this rejection for at least the following reasons. Claims 5 and 6 depend from allowable base claim 1 and claims 18 and 19 depend from allowable base claim 13. More particularly, claims 5 and 6 depend from and further limit, in a patentable sense, allowable independent claim 1 and therefore are allowable as well. In addition, claims 18 and 19 depend from and further limit, in a patentable sense, allowable independent claim 13 and therefore are allowable as well.

Claims 10 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (US 6078348) and Hernandez in view of Kiyoura et al. (US 4841506). Applicant respectfully traverses this rejection for at least the following reasons. Claim 10 depends from allowable base claim 1 and claim 15 depends from allowable base claim 13. More particularly, claim 10 depends from and further limits, in a patentable sense, allowable independent claim 1 and therefore is allowable as well. In addition, claim 15 depends from and further limits, in a patentable sense, allowable independent claim 13 and therefore is allowable as well.

Claims 12 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (US 6078348) in view of Hernandez in further view of Bedard (US 5801747). Applicant respectfully traverses this rejection for at least the following reasons. Claim 12 depends from allowable base claim 1 and claim 20 depends from allowable base claim 13. More particularly, claim 12 depends from and further limits, in a patentable sense, allowable independent claim 1 and therefore is allowable as well. In addition, claim 20 depends from and further limits, in a patentable sense, allowable independent claim 13 and therefore is allowable as well.

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Klosterman et al. (US 6078348) and Hernandez in view of Tanaka (US 5617571). Applicant respectfully traverses this rejection for at least the following reasons. Claim 17 depends from allowable base claim 13. More particularly, claim 17 depends from and further limits, in a patentable sense, allowable independent claim 13 and therefore is allowable as well.

Conclusion

It is clear from all of the foregoing that independent claims 1 and 13 are in condition for allowance. Dependent claims (2, 4-12), and (14-15, 17-20) depend from and further limit independent claims 1 and 13, respectfully, and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced.

Withdrawal of the Final Action and an early formal notice of allowance of claims 1, 2, 4-15, and 17-20 is requested.

Respectfully submitted,

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